

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of)
Leslie S. Marco et al.) Group: 3721
Serial No.: 10/681,524)
Filed: October 8, 2003)
Title: TOP LIFT CARRIER AND METHOD OF) Examiner: Tawfik, Sameh
MANUFACTURE THEREFOR)

REPLY BRIEF OF APPELLANTS

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Examiner's Answer dated July 23, 2010, Appellants submit the following Reply Brief.

The following comments and arguments are submitted supplemental to the arguments submitted in the Appeal Brief of Appellants filed on June 17, 2010. Accordingly, the following remarks should be taken in conjunction with the arguments previously submitted and not as a replacement thereof.

Without conceding to any arguments or analyses made by the Examiner in the Examiner's Answer, including any arguments or analyses not specifically addressed herein, the Appellants submit the following

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ARGUMENT

Appellants acknowledge with appreciation the withdrawal of the rejection under 35 USC 112, first paragraph.

On pages 3-6 of the Examiner's Answer, the Examiner has simply repeated the rejections and analyses found in the Final Office Action, which rejections and analyses were addressed in the aforementioned Appeal Brief of Appellants. No new grounds of rejection were presented by the Examiner. Accordingly, the following comments and arguments are submitted with respect to the "Response to Argument" portion of the Examiner's Answer found on pages 6-8 of the Examiner's Answer. It is respectfully submitted that those responses by the Examiner clearly show errors in the Examiner's approach to the examination of the claims under appeal, necessitating that the Board reverse the rejections.

A. REPLY TO EXAMINER'S INTERPRETATION OF THE INDEPENDENT CLAIM

The Examiner states that during examination the claims must be interpreted as broadly as their terms reasonably allow. At the bottom of page 6 in the Examiner's Answer, the Examiner then identifies some (and only some) of the limitations recited in independent claim 1, and thereafter makes the following conclusion:

The claim recites a method of making container carrier, which in the broadest reasonable interpretation, could be seen as positioning two sheets together, forming holes in both sheets to come up with handle portion and carrier portion in the combined sheets. (Examiner's Answer, page 7, lines 3 – 5.)

Appellant's Comments

It is respectfully submitted that the examination guideline directing that claims must be interpreted as broadly as their terms reasonably allow does not encompass ignoring limitations found in the claims. In fact, MPEP 2143.03 clearly directs that all claim limitations must be considered. "'All words in a claim must be considered in judging the patentability of that claim against the prior art'" *In re Wilson*, 424 F. 2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). When evaluating claims for obviousness under 35 USC 103 all limitations of the claim must be considered and given

weight.

The Examiner's conclusion regarding the broadest reasonable interpretation of independent claim 1 completely ignores limitations found in claim 1 and even limitations which the Examiner included in the list at the bottom of page 6 in the Examiner's Answer.

The Examiner's statement of the broadest reasonable interpretation of claim 1 completely ignores the limitation found in claim 1 of connecting a handle sheet and a carrier sheet along a line of attachment.

The Examiner's statement of the broadest reasonable interpretation of claim 1 completely ignores the limitation found in claim 1 of forming a container holding portion in only one of the sheets, identified in claim 1 as the carrier sheet.

The Examiner's statement of the broadest reasonable interpretation of claim 1 completely ignores the limitation found in claim 1 of forming the container holding portion with first and second rows of apertures.

The Examiner's statement of the broadest reasonable interpretation of claim 1 completely ignores the limitation found in claim 1 of forming the first and second rows of apertures on opposite sides of the line of attachment.

The Examiner's statement of the broadest reasonable interpretation of claim 1 completely ignores the limitation found in claim 1 of forming the first and second rows of apertures after the steps of positioning and connecting the sheets.

The Examiner's statement of the broadest reasonable interpretation of claim 1 completely ignores the limitation found in claim 1 of forming the handle portion only in the other of the sheets, identified in claim 1 as the handle sheet.

The Examiner's statement of the broadest reasonable interpretation of claim 1 completely ignores the limitation found in claim 1 of forming holes in the handle sheet simultaneously with forming the first row of apertures.

The Examiner's statement of the broadest reasonable interpretation of claim 1 completely ignores the limitation found in claim 1 that forming the holes in the handle sheet and forming the first row of container receiving apertures in the carrier sheet are performed by cutting through overlying portions of the handle sheet and the carrier sheet to form the holes and apertures in overlying arrangement and in substantially the same configuration one over the other.

The words and phrases ignored by the Examiner are not just surplus baggage having no importance. Claim 1 recites a method for making a container carrier which includes handling and processing separate sheets in certain ways to form a container carrier having certain advantages and features. When read in its entirety, giving meaning and importance to all of the words contained therein, even when those words are interpreted in their broadest meanings, Claim 1 recites a method for making a type of container carrier having a specific arrangement of sheets and holes and apertures in each sheet such that container receiving apertures are formed in only one of the sheets and holes are formed for a handle portion only in the other of the sheets in an efficient and reliable manner. This method for making a container carrier provides significant advantages in forming a carrier in a cost efficient manner that can provide structural advantages depending upon material selected for the various sheets. Although specific, different materials are not required, the carrier made by the process and the process itself are different from processes previously known for making carriers.

The Examiner's statement of the broadest reasonable interpretation of claim 1 suggests that any method that would position sheets and form holes and apertures in the sheets in some configuration would meet the limitations of claim 1 for examination purposes. Clearly, this is not the case. As stated above, claim 1 read in its entirety provides a much more detailed method for making a container carrier of a certain configuration, not just any container carrier.

It is respectfully submitted that the Examiner's complete and total disregard for significant language included in claim 1 taints the entire examination of the rejected claims and requires that the Examiner's decision be reversed.

**B. REPLY TO EXAMINER'S CONTENTIONS REGARDING
REJECTION UNDER 35 U.S.C. § 103(a).**

A Contention by the Examiner

The Examiner contends that Appellants have argued that Broskow '465 does not teach the claimed invention as it does not show the use of two separate sheets, one as a carrier sheet and one as a handle sheet, instead showing a handle portion and a carrier portion in a common sheet. The Examiner then contends that Slomski '659 discloses the teaching of using two separate sheets, one for the purpose of forming only handles in the handle sheet while the other sheet is for the purpose of forming only the carrier in the carrier sheet. The Examiner references Fig. 4 of Slomski '659 and the sheets 26 and 24 shown therein.

Appellant's Comments

The Examiner's responsive comments concerning Broskow '465 and Slomski '659 do not address the argument presented by Appellants. Slomski teaches separate and independent manufacture of a container engaging portion 24 and a handle portion 26 which are subsequently joined together after being formed. Broskow '465 teaches punching a single folded sheet or two overlying sheets so that each sheet includes both a container holding portion and a handle portion. Appellants have acknowledged as much in the summaries of the teachings of the cited references. However, neither Slomski nor Broskow or the combination thereof teaches how separate sheets can be used in an efficient stamping process to form a carrier having container engaging portions only in the carrier sheet and handle portions only in the handle sheet as recited in the rejected claims. Appellants have clearly stated in their original brief various inaccuracies in the Examiner's statements about the references (Appeal Brief of Appellants, pages 19-21) and the manner in which the combined teachings of the references fails to meet the limitations of rejected claim 1 (Appeal Brief of Appellants, pages 21-26). In short, claim 1 recites more than just a carrier having separate handle and carrier sheets. The combination of the teachings of Slomski and Broskow does not teach one skilled in the art how such a carrier can be made according to the method recited in claim 1.

It is respectfully submitted that a reading of the entirety of claim 1, including the limitations in claim 1 discussed above which the Examiner inexplicably ignores, leads to an inevitable

conclusion that claim 1 recites an invention that is not described or suggested by the combined teachings of Broskow '465 and Slomski '659. Accordingly, the Examiner's decision rejecting the claims should be reversed.

Another Contention by the Examiner

The Examiner contends that Broskow '465 "was only provided to show the teaching of having the step of forming container holding portion comes after the step of positioning and connecting sheets." (Examiner's Answer, page 7, lines 15-17.)

Appellant's Comments

This contention by the Examiner is not consistent with the final rejection or with the repetition of the final rejection as stated on page 4 of the Examiner's Answer. In the rejection and in the Examiner's argument in the Examiner's Answer, the Examiner states that Broskow discloses:

"...the step of forming first and second rows of container receiving apertures in the carrier sheet after the steps of positioning and connecting, and the step of forming holes in the handle sheet and the forming the first row of container receiving apertures in the carrier sheet being performed by cutting through overlying portions of the handle sheet and the carrier sheet to form holes and row of apertures in overlying arrangement". (Examiner's Answer; page 4, lines 10-14).

Clearly the Examiner has relied on the teaching of Broskow for more than just to show the step of forming a container holding portion after the step of positioning and connecting sheets.

The inadequacy of the Examiner's argument regarding the teaching of Broskow '465 has been addressed in the Appeal Brief of Appellants, so will not be repeated herein. However, the Examiner's contention that Broskow has been cited only for a very narrow limited purpose should not be given credence in view of the clear more extensive reliance on Broskow stated earlier in both the final rejection and in the Examiner's Answer.

A Further Contention by the Examiner

The Examiner contends that Appellants' argument for patentability relies on features not recited in the rejected claims, stating that providing a carrier that can be produced efficiently while using materials that can be different for both the carrier sheet and the handle sheet to optimize the performance of each are not recited in the rejected claims.

Appellant's Comments

It is respectfully submitted that the Examiner is attempting to confuse what Appellants have stated. On pages 25 and 26 of the Appeal Brief of Appellants, some of the advantages that are realized from the inventive method recited in the appealed claims are discussed. These include efficiency in handling, manufacture and use; and the ability to optimize materials of the individual sheets for specific purposes. The claims under appeal clearly recite a method for making a container carrier that provides these advantages. Appellants have not described those as recited elements of the claim, but as advantages that result from the recited method in which the container receiving apertures are formed in only one of the sheets, and the carrier holding portion is formed only in the other of the sheets in the method as claimed. For example, while the claim does not require that different materials be used for the separate sheets, the recited method enables that such can occur. This is an advantage of the invention. The appealed claims are for a method of making a container carrier, not for the carrier itself. The steps of the method for making the carrier clearly allow that different materials can be used if desired. That is an advantage of the invention, though not a requirement. The recited steps in the method enable the realization of advantages during manufacture and in use of a carrier manufactured in accordance with the method, including those discussed in the Appeal Brief of Appellants.

A Still Further Contention by the Examiner

The Examiner contends that Appellants have argued that neither applied reference alone or in combination teaches forming a carrier by attaching a handle sheet and carrier sheet one to the other before forming the container receiving apertures and the handle configuration. The Examiner then

references Broskow '465 while stating that what was not disclosed by Slomski '659 is disclosed by Broskow '465, which is the teaching of forming a carrier by attaching a handle sheet and carrier sheet one to the other before forming the container receiving apertures and the handle configuration.

Appellant's Comments

This contention by the Examiner ignores Appellant's argument in whole. Appellants have clearly stated in their original brief various inaccuracies in the Examiner's statements about the references (Appeal Brief of Appellants, pages 19-21) and the manner in which the combined teachings of the references fails to meet the limitations of rejected claim 1 (Appeal Brief of Appellants, pages 21-26) and dependent claims 2-7 (Appeal Brief of Appellants, pages 26-28). The Examiner's contention does nothing to refute Appellants' arguments.

CONCLUSION

For the foregoing reasons, and those contained in the Appeal Brief of Appellants filed June 17, 2010, Appellants submit that Appellants' invention as described in the appealed claims is not disclosed, anticipated or suggested by the cited references, alone or in combination, and the claims are therefore in condition for allowance in their present form. Accordingly, the Appellants respectfully request that the Board reverse the final rejection of the appealed claims.

Respectfully submitted,

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